

### SECTION III—REMARKS

This amendment is submitted in response to the Office Action mailed December 29, 2004. Claims 56-58 are amended herein, and claims 18-28 and 46-61 remain pending in the application. Applicants respectfully request reconsideration of the application and allowance of all pending claims in view of the following remarks.

#### Objected Claims

The Examiner objected to claims 56-58 because the phrase “the user-specified criteria” lacks antecedent basis in claim 54, from which claims 56-58 currently depend. As suggested by the Examiner, Applicants have amended claims 56-58 to depend on claim 55, which provides the necessary antecedent basis. Applicants thank the Examiner for her suggestion.

#### Rejections Under 35 U.S.C. § 103

The Examiner rejected all claims in the application under 35 U.S.C. § 103(a) as obvious in view of, and therefore unpatentable over, various combinations of the following references: U.S. Patent No. 6,502,750 to Barnes *et al* (“Barnes”); U.S. Patent No. 6,560,741 to Gerety *et al* (“Gerety”); U.S. Patent No. 5,515,962 to Kennedy *et al* (“Kennedy”); and U.S. Patent No. 5,768,023 to Sawaki *et al* (“Sawaki”). Specifically, the Examiner rejected claims 18, 46, 51-54 and 59-61 as unpatentable over Barnes in view of Gerety, rejected claims 19-24 as unpatentable over Barnes in view of Gerety and further in view of Kennedy, and rejected claims 25, 26, 47, 50, 55 and 58 as unpatentable over Barnes in view of Gerety and further in view of Sawaki.

Applicants respectfully traverse the Examiner’s rejections. Subject matter in a reference that qualifies as prior art under 35 U.S.C. § 102(e) cannot be used to reject claims in an application under 35 U.S.C. § 103(a) if, at the time the invention was made, the application and the reference were owned by the same person or entity or subject to an obligation of assignment to the same person or entity. 35 U.S.C. § 103(c); MPEP § 706.02(l)(1). In this case, Barnes and the present application were, at the time the claimed invention was made, owned by or subject to an obligation of assignment to the same

entity—Microscan Systems, Inc. In view of the common ownership of Barnes and the present application at the time of invention, Barnes cannot be used to reject any claims under § 103(a). Since every one of the Examiner's rejections under § 103(a) depends on Barnes, all the rejections are overcome by the disqualification of this reference. Applicants submit that these claims are therefore in condition for allowance, and respectfully request withdrawal of the rejections and allowance of the claims.

#### Conclusion

Given the above amendments and accompanying remarks, all claims pending in the application are in condition for allowance. If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to allowance of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.

#### Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

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